

REMARKS

Claims 1-17 are pending and stand ready for further action on the merits.

Support for new claims 14-15 can be found on page 11, first and second paragraphs.

Support for new claims 16-17 can be found on page 13, lines 15-22.

No new matter has been added by way of the above-amendment. The above-amendment to the claims does not narrow the scope of the invention and/or has not been made for the sake of patentability.

Interview

Applicants note with appreciation that the Examiner has conducted an Interview with Applicants' representative at the United States Patent and Trademark Office on December 14, 2004. The Examiner was very helpful in clarifying the single prior art based rejection.

On the Interview Summary form, the Examiner summarizes the interview as follows:

Discussed distinctions between the instant claims and the prior art of record, and the examiner will further consider applicant's arguments when submitted in forthcoming response.

We now provide further details of the discussion with the Examiner in connection with the prior art based rejection.

Prior Art Based Rejections

Claims 1-13 are rejected under 35 U.S.C. § 102(b) as being anticipated by Hashino et al., USP 5,914,211. Applicants respectfully traverse the rejection.

Hashino et al. teach a hydrophilic resin layer containing a hydrophilic polymer linked to a hydrophobic polymer. When the hydrophilic resin layer is used in the photosensitive lithographic printing plate, it is used as a dampening water receiving layer. When the hydrophilic resin layer is used in the image-adding type lithographic printing plate, it is used as an image-receiving layer. (See abstract).

A careful review of the entire disclosure of Hashino et al. reveals that the description of the hydrophilic resin layer is very broad. In fact, the Examiner has applied Hashino et al. under 35 USC 102 (anticipation) only and has not cited the reference under 35 USC 103 (obviousness). Accordingly, the Examiner's comments are directed to the exemplified embodiments of Hashino et al. In the outstanding Office Action, the Examiner does not comment on the aspects of the present invention that the Examiner may find that Hashino et al. fairly suggest.

Applicants now address the anticipation rejection.

As noted during the December 14, 2004 Interview, the present invention is not anticipated by Hashino et al., since Hashino et al. do not place in the possession of the public the inventive resin composition for lithographic printing plates. Important in the analysis under 35 USC 102, is the fact that the exemplified embodiments of Hashino et al. do not meet the inventive claim limitations. Specifically, in Example 1 at column 12, lines 5-10, Hashino et al. teach a composition of the coating fluid for a dampening water receiving layer containing:

Polyammonium acrylate-grafted methoxymethylated
polyamide resin (Toresin FS350, a product of
Teikoku Chemical Industry Co., Ltd., solid
content: 20%, extent of grafting: 30%): 100
parts

Urea resin (U-RAMIN P1500, a product of Mitsui Toatsu
Chemicals, Inc., solid content: 40%): 5 parts..

The Examiner is equating the ammonium acrylate polymer of Hashino et al. with the inventive "hydrophilic polymer having at least a hydrophilic group" and the urea resin of Hashino et al. with the inventive "compound that inhibits hydrogen bonding within the molecule and/or between the molecules of the hydrophilic polymer".

As noted during the Interview, the ammonium acrylate polymer is actually only the grafted portion of a polyamide resin. The polyamide is a hydrophobic resin not a hydrophilic

resin as presently claimed. In the present invention, the hydrophilic polymer may contain hydrophobic portions, however, it is clear from the disclosure at page 14, line 6 to page 18, line 1 of the present specification that the polyammonium acrylate-grafted methoxymethylated polyamide resin of Example 1 of Hashino et al. would not be considered by the skilled artisan to be a hydrophilic polymer, as presently claimed.

Furthermore, it is clear that the urea resin of Example 1 of Hashino et al. is a crosslinking agent, and as such, would not serve the function of inhibiting "hydrogen bonding within the molecule and/or between the molecules of the hydrophilic polymer" as required by the present claims. With respect to inventive claims 2 and 6, these claims are further distinguished from Hashino et al., in that the ammonium acrylate ($\text{CH}_2=\text{CH}-\text{COONH}_4$) of Hashino et al. is not encompassed by inventive general formula (1) described in claims 2 and 6.

Similar distinctions are apparent between the presently claimed hydrophilic polymer and the polymers of Examples 2-13 of Hashino et al.

In describing the requirements for rejection of a claim by anticipation, the Manual of Patent Examining Procedure (Section 2131) states:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference (ref. omitted). The identical invention must be shown in as complete detail as is contained in the... claim (ref. omitted)."

Furthermore, in *Ex Parte Levy*, 17 USPQ2d 1461 (BPAI, 1990), the Board of Patent Appeals and Interferences has written:

"Moreover, it is incumbent upon the Examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference (ref. omitted)."

Accordingly, Applicants respectfully indicate, every element in a claim must be found in the reference in order that the reference anticipates the claim. Neither the hydrophilic polymer having at least a hydrophilic group nor a compound that inhibits hydrogen bonding within the molecule and/or between the molecules of the hydrophilic polymer can be found in Hashino et al. Therefore, Hashino et al. do not anticipate the claims, and as such, Applicants respectfully request that the rejection be withdrawn.

As an aside, as noted during the December 14, 2004 Interview, the present invention is allowable over Hashino et al., since Hashino et al. do not make obvious under 35 USC 103, the inventive resin composition for a lithographic printing plate.

It is Applicants' position that the teachings of Hashino et al. are so broad as to not fairly suggest modifying the exemplified embodiments of Hashino et al. to obtain the inventive composition. Obviousness does not exist if the prior art neither indicates which of the disclosed parameters are critical nor gives direction as to which of many choices is likely to be successful. *Merck & Co., Inc. v. Biocraft Labs., Inc.* (CAFC 1989) 874 F2d 804.

For the Examiner to hold otherwise (to find the invention obvious over Hashino et al.) would be the equivalent of using improper hindsight reconstruction. A proper analysis of the text of section 103, gives weight to the phrase "at the time the invention was made." For it is this phrase that guards against entry into the "tempting but forbidden zone of hindsight," see *Loctite Corp. v. Ultraseal Ltd.*, 228 USPQ 90 (Fed. Cir. 1985), when analyzing the patentability of claims pursuant to that section. Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field, see, e.g., *W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983). The case law makes clear that the best defense against the subtle but

powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to make the modifications to a reference's teachings necessary to obtain the present invention, see e.g., *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988).

Here there is no adequate motivation provided by Hashino et al. for the skilled artisan to make or use the present invention in the disclosure of the large number of variants for the composition.

Based on the foregoing, the present invention is clearly patentable over Hashino et al.

Conclusion


In view of the above amendments and comments, Applicants respectfully submit that the claims are in condition for allowance. A Notice to such effect is earnestly solicited.


Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact **Garth M. Dahlen, Ph.D., Esq.** (Reg. No. 43,575) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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